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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,606	05/05/2005	Maria Cristina Geroni	17703 (PC27210A)	4724
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Peter I Bernstein Scully Scott, Murphy & Presser 400 Garden City Plaza Suite 300 Garden City, NY 11530				
EXAMINER				
WEBB, WALTER E				
ART UNIT		PAPER NUMBER		
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MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,606

Applicant(s)

GERONI ET AL.

Examiner

WALTER E. WEBB

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13-15 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13-15 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Unless specifically repeated/maintained *infra*, all previous rejections or objections are withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112 (new)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 8, 10, 11, 15, 25, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 3, 8, 10, 11, 15, 25, and 27 contains research designations, e.g., STI571, ZD1839, OSI774, SU5416 etc. Such designations are basically equivalent to trademarks or tradenames, since they are specific to their research source. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or

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trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe protein kinase inhibitors and, accordingly, the identification/description is indefinite.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 24-30 recite the broad recitation "in a mammal", and the claim also recites "including humans" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103(previous)

Claims 1-3, 5-11, 13-15 and 24-30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Cozzi et al. (WO 98/04524, published February 5, 1998) in view of Sironak et al., (Clinical Cancer Research: 2000, 6 (12); 4885-4892) and further in view of Grimley et al., (US 6,274,576).

Applicant argues that Cozzi et al. does not teach an α -bromo or α -chloro- acryloyl distamycin compound of formula (I) can be combined with a protein kinsase inhibitor. However, the reference teaches combining a compound of the instant formula (I) with an anti-tumor agent, which includes protein kinase inhibitors.

Applicant argues that the cytotoxic agents of Sironak et al. are structurally and functionally different from the compounds of Cozzi. However, the compounds are not functionally different since the compounds of Sironak and Cozzi function to treat lung carcinoma. (See abstract of Sironak and pg. 16, line 7 of Cozzi.)

Applicant argues that ZD1839, instantly claimed and taught in Sironak, is unpredictable in its synergistic effect with cytotoxic agents, citing from Sironak that the compound has “no enhanced antitumor activities or confers exceedingly high toxicity respectively.” Applicant also cites from Knight LA et al., Exhibit A, that ZD1839 has both positive and negative effects when used in combination with different cytotoxic agents. Based on these data, applicant argues that a person having ordinary skill in the art would not have a reasonable expectation of success in combining ZD1839 with any type of cytotoxic agent. However, the issue is not whether the artisan would combine

ZD1839 with any cytotoxic agent, but whether the artisan would combine ZD1839 with the compound(s) of Cozzi. As previously argued, the motivation to combine the compound(s) of Cozzi with ZD1839 stems from the fact that both compound are taught to be useful in treating cancer e.g. lung cancer. The motivation to combine is further enhanced by the fact that the art recognizes ZD1839's usefulness in improving cytotoxicity of a diverse group cytotoxic agents, including a successful treatment of lung cancer. Because of this diversity the artisan would have a reasonable expectation of success when combining it with a compound of Cozzi, especially given the successful treatment of lung cancer.

Applicant argues that the indole carbozoles of Grimley are structurally and functionally different from the compound(s) of Cozzi. Although Grimley is relied on to show support for a motivation to combine a protein kinase with a cytotoxic agent, the indole carbozoles do, however, function similarly with the compound(s) of Cozzi since they are used to treat cancer. (See col. 5, lines 26-44.)

Obvious-type Double Patenting(previous)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-11, 13-15 and 24-30 remain rejected on the ground of nonstatutory obvious-type double patenting as being unpatentable over claims 1-10 of U.S.

Patent No. 6,482,920 (Cozzi) in view of Sirotnak et al., (Clinical Cancer Research: 2000, 6 (12); 4885-4892).

Applicant makes the same argument above with regard to this obvious-type double patenting rejection.

For the reasons stated above in the 35 USC § 103(a) rejection, the rejection under the obvious-type double patenting is also maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER E. WEBB whose telephone number is (571)270-3287. The examiner can normally be reached on 8:00am-4:00pm Mon-Fri EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Walter E. Webb
/Walter E Webb/
Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612